

II. REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1, 4, 19, 23, 24, 28 and 34-37 were examined and stand variously objected to or rejected in the outstanding Office Action. Claims 7-11 had previously been withdrawn from consideration as a result of a requirement for restriction. Claims 29 and 30 had previously been withdrawn by the Office as being allegedly directed to the subject matter of the non-elected invention of Group II. Applicants traversed the withdrawal of claims 29 and 30 and requested reconsideration and examination. The Office maintained the withdrawal in the outstanding Office Action.

Claims 1, 19, 24, 29 and 36 are currently being amended.

Claim 1 has been amended to improve clarity. Support for the amendment is found on page 9, lines 21 to page 10 line 10 of the specification of the originally filed application.

Claims 19 and 24 have been amended to recite a therapy for the treatment in the preamble to provide antecedent basis. Claim 24 has also been amended to correct a typographical error.

Claim 29 has been amended further to the July 13, 2009 telephonic interview with Applicant's counsel. Support for the amendment is found on page 9, lines 21 to 31, and page 26, lines 2 to 5 of the specification of the originally filed application.

Claim 36 has been amended to recite various samples that can be used with the method. Full support for the amendment is independently found on page 25, lines 13 to 17 and lines 21 to 23 of the specification of the originally filed application, or page 21, lines 3 to 6 and lines 10 to 12 of Provisional Application Serial No. 60/400,253.

Thus, the amendment to claims 1, 19, 24, 29 and 36 does not raise an issue of new matter and entry thereof is respectively requested.

Applicants' amendment of the claims as previously presented is made without prejudice to Applicants' right to pursue the same or similar claims in a related continuing application. The amendment of the claims is not intended to be a dedication to the public of the subject matter of the claims as previously presented.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

In view of the preceding amendments and the remarks below, reconsideration and withdrawal of the objections and rejections is respectfully requested. After amending the claims as set forth above, claims 1, 4, 7-11, 19, 23, 24, 28-30 and 34-37 are now pending in this application. Claims 7-11 had previously been withdrawn from consideration.

Statement of Substance of Interview

Applicants held a telephone interview with the Examiner on July 13, 2009. An interview summary was issued by the Office on July 16, 2009.

Applicants presented no exhibit during the interview. Claim 29 was discussed during the interview and in particular, how it may be amended for removal of the rejection on the ground it was directed to non-elected subject matter. Applicants suggested an amendment but the Examiner could not state whether the rejection would be removed upon presentation of the amended claim.

Election/Restrictions

Claims 29 and 30 stand withdrawn from consideration and examination. In the reply of March 5, 2009, Applicants traversed the withdrawal of claims 29 and 30. The

Office maintained the withdrawal alleging that claims 29 and 30 were directed to the subject matter distinct from that of the elected invention. The elected invention, the Office alleged, includes an active process of screening a patient for the presence of a C/C genotype at codon 118 of the ERCC1 gene.

In response to the rejection, claim 29 has been amended to recite that the patient being treated was selected for the treatment based on the presence of the (C/C) genotype of the ERCC1 gene. In addition, the genotype was determined by a method comprising screening a patient sample for the genotype of the ERCC1 gene at codon 118 as noted in claims 1 and 10. Claim 30 depends from claim 29 and thus includes the same limitation.

In view of the amendment, Applicants respectfully traverse the withdrawal of claims 29 and 30 and request reconsideration and examination of claims 29 and 30.

Claim Objections

Claims 36 and 37 stand objected to for allegedly being dependent from withdrawn claim 29. As provided above, Applicants has requested removal of the withdrawal of claim 29 which will then render this objection moot.

Claim 24 stands objected to for the redundant word "genotype" in the phrase "not having the genotype (C/T) or (T/T) genotype". Claim 24 has been amended to remove the redundancy rendering this objection moot.

Claim Rejections – 35 USC § 112 Second Paragraph

Claims 1, 4, and 34-37 stand rejected as allegedly being indefinite for reciting "the patient is not selected for the therapy". Claim 1 has been amended to recite "the therapy is not selected for the patient". Claims 4 and 34-37 depend from claim 1. Therefore, the amendment to claim 1 renders the rejection moot.

Claims 19, 23, 24, 36 and 37 stand rejected as allegedly being indefinite over the recitation of "said therapy" or "the therapy" which lacks proper antecedent bases. Claims 19 and 24 have been amended to replace "treatment" with "treatment with a therapy" to provide antecedent basis for "said therapy" and "the therapy". Claim 23 depends from claim 19. Claims 36 and 37 depend from claim 19 or claim 24. The amendment to claims 19 and 24 thus renders this rejection moot.

Priority

The Office alleged that claim 36 was entitled to priority to PCT/US03/24064, but not to provisional application 60/400,253. Without conceding to the correctness of the Office's allegation and in a sincere effect to advance the prosecution, claim 36 has been amended to recite samples that are literally recited in the provisional application. Applicants believe that claim 36, as currently amended, is entitled to the priority to provisional application 60/400,253, July 13, 2002. Reconsideration and examination of the claim is respectfully requested.

Claim Rejections – 35 USC § 103

Claim 36 stands rejected as allegedly being obvious over Park et al. under 35 USC § 103. The Office acknowledged the previous rejection over Park was obviated by Applicants' filing of the 132 Declaration establishing that Park is not prior art to the claimed invention because the work described by Park is that of the present inventors. The rejection on claim 36 was due to the alleged lack of the priority from the provisional application.

As provided above, claim 36 as currently amended, is entitled to the priority to the provisional application, July 13, 2002, which is less than one year following publication of Park. Therefore, Park is not a qualifying 35 USC § 103 prior art reference against claim 36. Removal of the rejection is respectfully requested.

Supplemental Information Disclosure Statement

Attached to this Reply is a Supplemental Information Disclosure Statement listing references for consideration and entry into the application file. Applicants respectfully request that the Office acknowledge same by initializing the SB/08 document and returning the initialed copy to Applicants' attorney in the next correspondence.

[The remainder of this page is left intentionally blank.]

III. CONCLUSION

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date: August 10, 2009

By 

FOLEY & LARDNER LLP
Customer Number: 38706
Telephone: (650) 251-1129
Facsimile: (650) 856-3710

Antoinette F. Konski
Attorney for Applicants
Registration No. 34,202